REMARKS

Claims 1-7, 9-15, and 17-23 stand under 35 U.S.C § 102 as being anticipated by Raman. As will be shown below, Raman does not disclose each and every element of Applicants' claims and does not enable Applicants' claims. Raman therefore does not anticipate Applicants' claims. Claims 1-7, 9-15, and 17-23 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1-7, 9-15, and 17-23.

Claims 8, 16, and 24 stand rejected under 35 U.S.C § 103 as obvious over Raman in view of Josephson. As will be shown below, the combination of Raman and Josephson does not teach or suggest each and every element of Applicants' claims. Claims 8, 16, and 24 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 8, 16, and 24.

Double Patenting Rejections

Claims 1, 3, 4, 7, 8, 9, 10, 11, 12, 15, 16, 17, 18, 19, 20, 23 and 24 are provisionally rejected on the ground of non-statutory double patenting over claims 1, 8, 9, 11, 10, 12, 18, 19, 20, 22, 21, 23, 29, 30, 31, 33, and 32 respectively, of co-pending Application No. 10/733,947. In response, Applicants herewith submit a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321 for the present application to cure the double patenting rejections in the present application.

General Comments Regarding Terminology

The Office Action at page 6 states that "it is noted that the claims specify a number of non-standard terms that define the invention. To clarify the Examiner's reading of the claims, the following definitions are derived from the claims and specification and stated using standard terminology…" Applicants note with respect that claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000) cited in M.P.E.P. §2111.

Words of the claims must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) cited in M.P.E.P. § 2111. Words in a claim are generally not limited in their meaning by what is shown or disclosed in the specification. See, e.g., *Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 906, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004)(discussing recent cases wherein the court expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment). See *Superguide Corp. v. DirectTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Circ. 2004) ("Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." See *E-pass Techs., Inc. v. 3Com corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) which states that "Interpretation of descriptive statements in a patent's written description is a difficult task, as an inherent tension exists as to whether a statement is a clear lexicographic definition or description of a preferred embodiment. The problem is to interpret claims 'in view of the specification' without unnecessarily importing limitations from the specification into the claims."

The Office Action has impermissibly imported limitations from exemplary embodiments into the claims by attempting to define claim elements through use of descriptive statements in Applicant's specification. The Office Action at pages 6-9, for example, defines terms used in the claims in the present specification in ways that are inconsistent with the usage of the terms in the specification. Such terms include including 'presentation document,' 'structured document,' 'structural identifiers' or 'structural element identifiers,' 'structural elements,' 'classifying' structural elements,' and 'presentation attribute.' The Office Action in the fourth paragraph of page 6, for example, defines the term "presentation document" as the term is used in a specific exemplary embodiment from the original specification in this case, effectively reading

that exemplary embodiment into the claims of the present application. This type of limitation by the Office Action is prohibited as seen in *Superguide Corp.* and *E-pass Techs.* above. In other cases the Office Action has impermissibly modified Applicant's definitions arbitrarily. Rejections based on impermissible definitions cannot stand, and Applicants, as explained in more detail below, respectfully requests withdrawal of those rejections. In light of *Festo Corp. v. Shoketsu Kinzoku Kogyokabushiki Co.*, 535 U.S. 722 (2002), Applicants decline to make any further comment regarding the interpretation of the claim language in the present application.

Claim Rejections Under 35 U.S.C. §102 Over Raman

Claims 1-7, 9-15, and 17-23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Raman (U.S. Patent No. 5,748,186) (hereafter "Raman"). The Office Action rejects the claims on identical grounds as those raised in the previous Office Action dated January 12, 2006. Applicants hereby incorporate the Response dated April 5, 2006 to the January 12, 2006 Office Action and raise all previous arguments to the current rejections of claims 1-7, 9-15, and 17-23. The current Office Action at page 18 responds to Applicant's previous arguments. As will be shown below, Raman does not anticipate creating a presentation document as claimed in the present application. Claims 1-7, 9-15, and 17-23 are therefore patentable and should be allowed. Applicant's answer each of the responses raised in the current Office Action individually below and request reconsideration of claims 1-7, 9-15, and 17-23.

Claims 1-7, 9-15, and 17-23 stand rejected under 35 U.S.C § 102(b) as being anticipated by Raman. To anticipate claims 1-7, 9-15, and 17-23 under 35 U.S.C. § 102(b), two basic requirements must be met. The first requirement of anticipation is that Raman must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Raman must enable Applicants' claims. Raman does not meet either requirement and therefore does not anticipate Applicants' claims.

Raman Does Not Disclose Each and Every Element
Of The Claims Of The Present Application

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As explained in more detail below, Raman does not disclose each and every element of claim 1, and Raman therefore cannot be said to anticipate the claims of the present application within the meaning of 35 U.S.C. § 102.

Independent claim 1 recites:

1.   A method for creating a presentation document, the method comprising:

creating, in dependence upon an original document, a structured document comprising one or more structural elements; and

creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes a structural element identifier for at least one structural element of the structured document.

Raman Does Not Disclose Creating A Presentation Grammar
For The Structured Document, Wherein The Presentation
Grammar For The Structured Document Includes Grammar
Elements Each Of Which Includes A Structural Element Identifier
For At Least One Structural Element Of The Structured Document

The Office Action takes the position that Raman at claim 22 discloses the second element of claim 1: "creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes a structural element identifier for at least one structural element of the structured document." Applicants respectfully note in response that what Raman at claim 22 in fact discloses is:

An interactive system according to claim 14, wherein:

the input device includes a speech input unit;

the at least two modalities include an aural presentation modality; and

with the aural presentation modality selected, interactivity between the interactive system and the user is accomplished using only speech.

That is, Raman at this point discloses an interactive system for presenting source information in which the interactivity is accomplished using speech. Raman's interactive system using only speech does not disclose creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes a structural element identifier for at least one structural element of the structured document – as claimed in the present application. In fact, Raman does not even mention at this point or anywhere else 'grammar,' 'presentation grammar,' 'grammar elements,' or 'creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes a structural element identifier for at least one structural element of the structured document.'

In "Response To Arguments" on page 19 of the Office Action, the Examiner takes the position that Raman "fully anticipates the 'presentation grammar' by teaching association of the presentation of information tied to control by voice commands." Raman, however, in fact does not teach association of presentation of information tied to control by voice commands. What Raman teaches is "interactivity between the interactive system and the user is accomplished using only speech." Again, interactivity using speech does not teach creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes a structural element identifier for at least one structural element of the structured document – as claimed in the present application. Even if Raman in fact uses a presentation grammar in effecting interactivity with speech, no one will ever know, because no such grammar is described in Raman. Moreover, there is no need for a

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grammar necessarily or inherently in Raman, because, as is well known, speech recognition and speech interactivity can be carried out by so-called dictation systems that use large language dictionaries with no grammars of any kind, no voice recognition grammars, and no presentation grammars.

Because Raman does not disclose the second element of claim 1, Raman does not disclose all the elements and limitations of claim 1. Because Raman does not disclose each and every element and limitation of Applicants' claims, Raman does not anticipate Applicants' claims, and the rejections under 35 U.S.C. § 102 should be withdrawn.

Raman Does Not Enable Each and Every Element Of The Claims Of The Present Application

Not only must Raman disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Raman must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in Hoeksema stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Raman places Applicants' claims in the possession of a person of ordinary skill in the art, Raman is legally insufficient to anticipate Applicants' claims under 35 U.S.C. § 102(b).

In the "Response To Arguments" on page 20, the Office Action takes the position that Raman at figure 3, element 310 320, 360 361, and 362, column 4, lines 38-43, column 4, lines 44-64, and column 3 lines 30-34 discloses "presentation document" as claimed in

the present application. Applicants respectfully note in response that what Raman at column 4, lines 38-43 actually discloses is:

> Typically, the source document 111 is received by the retriever 120 as a sequential stream of digitally encoded signals, for example ASCII characters. The characters encode the text as well as the marks placed in the text to define the structure of the document 111; see FIG. 3 for description.

And what Raman at column 4, lines 44-64 actually discloses is:

> The recognizer 130 parses the character stream into fundamental source elements, for example, title, sections, sub-sections, paragraphs, sentences, links, and forms, and so forth. The elements are stored in the intermediate high-level data structure 200. Variations in writing styles, and ambiguities in the use of the markup language make the extraction of the high level structure 200 difficult. The recognizer 130 uses a lex-based translator to generate a nested list representing the source document 111; see FIG. 4 for description.

> As shown in FIG. 2, in the preferred embodiment, the nested list can be logically shown as a data structure in the form of a hierarchical attributed tree. The tree 200 is shown in the usual upside down manner with the root at the top, and the leaves at the bottom. The tree 200 includes a plurality of nested containers or nodes. Each node encapsulating a specific portion and type of document content. Each node or container is known as a document object. An object is an encapsulation of data 221, and methods 222 which operate on, or according to, the data.

And what Raman at column 3, lines 30-34 actually discloses is:

> An interactive interface 150 coupled to I/O devices 160 can be used to control the retriever 120 and the presentor 140. The I/O devices 160 can include a monitor, a keyboard, a mouse, a telephone key-pad, a voice input unit coupled to a speech recognizer, and a speech synthesizer.

That is, what Raman discloses at these points is a source document that is received and parsed into fundamental source elements and an interactive interface coupled to an I/O device for controlling a retriever and presentor. Raman's source document, fundamental source elements, and interactive interface definitely do not disclose a "presentation

document" as claimed in the present application. In order to try to fit Raman's disclosure into the claims of the present application, the Office Action at page 20 improperly attempts to define the term "presentation document" so that it will read on Raman. The Office Action attempts to define "presentation document" by use of a specific exemplary embodiment from Applicant's original specification to include "a markup language document" and "keywords," effectively reading that exemplary embodiment into the claims of the present application. In fact, Applicant's original specification at page 11, lines 14-17 states that "markup language" is not a limitation of the present invention, and the term "markup language" occurs nowhere in the claims. The "presentation document" as claimed by the present invention therefore cannot be limited to the definition which the Office Action has improperly attempted to read into claim 1. Raman does not disclose a presentation document as claimed here, and, not disclosing presentation document, Raman certainly cannot be said to enable a presentation document. Because Raman does not place in the possession of a person of ordinary skilled in the art each and every element and limitation of Applicants' claims, Raman does not anticipate Applicants' claims, and the rejections should be withdrawn.

Raman Does Not Place In The Possession Of A Person Of Ordinary Skilled In The Art Creating A Presentation Grammar For The Structured Document, Wherein The Presentation Grammar For The Structured Document Includes Grammar Elements Each Of Which Includes A Structural Element Identifier For At Least One Structural Element Of The Structured Document

The Office Action takes the position that Raman at column 4, lines 38-43, column 3, lines 30-34, and column 2, lines 42-44 discloses creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes a structural element identifier for at least one structural element of the structured document as claimed in the present application. Applicants respectfully note in response that what Raman at column 4, lines 38-43 actually discloses is:

> Typically, the source document 111 is received by the retriever 120 as a sequential stream of digitally encoded signals, for example ASCII

characters. The characters encode the text as well as the marks placed in the text to define the structure of the document 111; see FIG. 3 for description.

And what Raman at column 3, lines 30-34 actually discloses is:

An interactive interface 150 coupled to I/O devices 160 can be used to control the retriever 120 and the presentor 140. The I/O devices 160 can include a monitor, a keyboard, a mouse, a telephone key-pad, a voice input unit coupled to a speech recognizer, and a speech synthesizer.

And what Ramat at column 2 liens 42-44 actually discloses is:

As an advantage, the user can browse through the document taking the structure of the document into consideration.

That is, Raman discloses at these points browsing a source document taking the structure of the document into consideration and an interactive interface coupled to an I/O device – none of which discloses or enables creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes a structural element identifier for at least one structural element of the structured document as claimed in the present application. In fact, Raman at these points, does not even mention 'grammar,' 'presentation grammar,' 'grammar elements,' or 'creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes a structural element identifier for at least one structural element of the structured document.' Because Raman does not place in the possession of a person of ordinary skilled in the art each and every element and limitation of Applicants' claims, Raman does not anticipate Applicants' claims, and the rejections should be withdrawn.

The Office Action attempts to use the theory of inherency to supply the disclosure missing from Raman. The Office Action at page 21 states:

> It is inherent within the ability to verbally "browse through the document" based on its structure, combined with the fact that the document is marked according to structure, and the fact that verbal commands can control the "browsing," that Raman contains what the Applicants have labeled a "grammar" with a "structural element identifier." Raman does not use the Applicant's non-standard terminology, but Raman teaches the invention claimed.

That is, the Office Action invokes the theory of inherency as a basis for rejection of elements of claim 1 in the present application. The Office Action takes the position in effect that some disclosure in Raman necessarily results in the claim elements, creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes a structural element identifier for at least one structural element of the structured document. The rejection, however, is not accompanied by the required analysis to support a rejection relying on inherency. Merely reciting the word "inherent" is insufficient basis for a rejection on the theory of inherency. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) cited in MPEP § 2112. The Office Action does not demonstrate in any way that anything in Raman necessarily results in creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes a structural element identifier for at least one structural element of the structured document. In fact, such inherency does not exist. Creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes a structural element identifier for at least one structural element of the structured document cannot properly be said to necessarily flow from any of the teaching in Raman within the meaning of *Levy*.

The Office Action concludes this line of argument with the conclusion: "Raman does not use the Applicant's non-standard terminology, but Raman teaches the invention claimed."

Applicants note in response that Raman not only does not use Applicants' terminology, Raman uses no terminology that is even remotely similar to Applicants' terminology. And the reason that Raman uses no terminology that is even remotely similar to Applicants' terminology is that Raman does not disclose Applicants' invention as claimed in the present application.

Raman does not disclose creating a presentation grammar for a structured document as claimed here, and, not disclosing creating a presentation grammar for a structured document, Raman certainly cannot be said to enable creating a presentation grammar for a structured document. Because Raman does not place in the possession of a person of ordinary skilled in the art each and every element and limitation of Applicants' claims, Raman does not anticipate Applicants' claims, and the rejections should be withdrawn.

Claims 8, 16, and 24 Stand Rejected Under 35 U.S.C. § 103

Claims 8, 16, and 24 stand rejected under 35 U.S.C § 103(a) as unpatentable over Raman in view of Josephson (U.S. Patent Publication No. 2003/0023435 A1) (hereafter "Josephson"). To establish a prima facie case of obviousness under 35 U.S.C. § 103 the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As explained below, the combination of Raman and Josephson does not establish a prima facie case of obviousness for claims. Applicants respectfully traverse the rejections of claims 8, 16, and 24.

The Combination Of Raman and Josephson Does Not Teach All Of Applicants' Claim Limitations Of Dependent Claims 8, 16, and 24

In rejecting dependent claims 8, 16, and 24, the Office Action relies on the previous §102 rejection arguing that Raman discloses each and every limitation of claims 1, 9, and 17. As explained above, however, Raman does not disclose each and every element of independent claims 1, 9, and 17. To establish a prima facie case of obviousness, the

proposed combinations of the references must teach or suggest all of the claim limitations of dependent claims 8, 16, and 24. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Dependent claims 8, 16, and 24 include all limitations of independent claims 1, 9, and 17 respectively. Because the proposed combination of Raman and Josephson relies on the argument that Raman teaches each and every element of independent claims 1, 9, and 17, and because Raman in fact does not teach or suggest each and every element of independent claim 1, 9, and 17, the proposed combinations cannot teach or suggest all the claim limitations of dependent claims 8, 16, and 24. The proposed combination of Raman and Josephson therefore cannot establish a prima facie case of obviousness, and the rejections should therefore be withdrawn.

Relations Among claims

Independent claims 9 and 17 are system and computer program product claims for creating a presentation document corresponding to independent method claim 1 that include "means for" and "means, recorded on [a] recording medium, for" creating a presentation document.

For the same reason that Raman does not disclose or enable a method for creating a presentation document, Raman also does not disclose or enable systems and computer program products for creating a presentation document corresponding to independent system claims 9 and 17. Independent claims 9 and 17 are therefore patentable and should be allowed.

Claims 2-8, 10-16, and 18-24 depend respectively from independent claims 1, 9, and 17. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because Raman does not disclose or enable each and every element of the independent claims, Raman does not disclose or enable each and every element of the dependent claims of the present application. As such, claims 2-8, 10-16, and 18-24 are also patentable and should be allowed.

Conclusion

Claims 1, 3, 4, 7, 8, 9, 10, 11, 12, 15, 16, 17, 18, 19, 20, 23 and 24 are provisionally rejected on the ground of non-statutory double patenting over claims 1, 8, 9, 11, 10, 12, 18, 19, 20, 21, 22, 23, 29, 30, 31, 33, and 32 respectively, of co-pending Application No. 10/733,947. Applicants respectfully propose that the accompanying Terminal Disclaimer cures the rejections of claims 1, 3, 4, 7, 8, 9, 10, 11, 12, 15, 16, 17, 18, 19, 20, 23 and 24 in the present application on the grounds of non-statutory double patenting

Claims 1-7, 9-15, and 17-23 stand under 35 U.S.C § 102 as being anticipated by Raman. Raman does not disclose each and every element of Applicants' claims and does not enable Applicants' claims. Raman therefore does not anticipate Applicants' claims. Claims 1-7, 9-15, and 17-23 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1-7, 9-15, and 17-23.
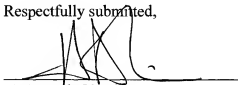
Claims 8, 16, and 24 stand rejected under 35 U.S.C § 103 as obvious over Raman in view of Josephson. The combination of Raman and Josephson does not teach or suggest each and every element of Applicants' claims. Claims 8, 16, and 24 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 8, 16, and 24.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: <u>September 27, 2006</u>   By: _____

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